



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|----------------------|------------------|
| 09/741,664 | 12/21/2000 | Ayoub Rashchian | 0942.3910003/RWE/BJD | 7736 |

26111 7590 11/18/2002

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON, DC 20005-3934

EXAMINER

SOUAYA, JEHANNE E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1634 | |

1634

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 1634

DETAILED ACTION

The examiner reviewing your application at the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to examiner Jehanne Souaya.

Election/Restriction

Claims 37-43 will be examined with whichever group is elected.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-33, 35, and 44-59 are, drawn to compositions comprising a thermostable enzyme or a thermostable DNA polymerase, kits comprising such compositions, and methods of using such compositions, classified in class 435, subclass 6.
 - II. Claims 34 and 36, drawn to methods of amplifying or sequencing using a composition containing a thermostable 3'exo+ and a thermostable 3'exo- DNA polymerase in equal or different concentrations, classified in class 435, subclass 91.2.
2. The inventions are distinct, each from the other because of the following reasons: the composition and method of Group I are different from the method of Group II. The methods of amplification and sequencing of Group II do not require the composition of group I, which require only a single thermostable DNA polymerase. Further, the methods of sequencing of group I do not require the composition used in the method of Group II, that is a composition comprising both a thermostable 3'exo- and a thermostable 3'exo+ DNA polymerase in equal or

Art Unit: 1634

different concentrations. The inventions require different reagents, reaction parameters and reaction conditions, and are patentably distinct from each other.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

Application/Control Number: 09/741,664

Page 4

Art Unit: 1634

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jehanne Souaya

Jehanne Souaya
Patent examiner
Art Unit 1634

11/14/02